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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,295	12/11/2000	George Bradley Hobbs	10003974-1	3877

7590 10/18/2005

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O.Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/734,295	HOBBS, GEORGE BRADLEY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Saeid Ebrahimi-dehKordy	2626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-21 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/21/05 has been entered.

### **Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-12, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zehr et al (Pub. No.: US 20010025274) in view of Kawai et al (U.S. Patent 6,404,994)

Regarding claim 11 Zehr et al disclose: A method of processing a print job of a customer and including advertising with the print job (please note Fig.2 items 26,66 and 44) the method comprising the steps of: defining a print processing system controller having a plurality of advertisements registered therewith (please note Fig.2 and page 5 lines 6-8) defining a network communication link between the customer and the print processing system controller (please note Fig.1 and 2 the way mail sender is communicating through the network to the advertisements and LPFs, page 2 paragraph 0027 through 0032) ((page 4 lines 27-34 and page 5 lines 1-31)) receiving a data file for

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the print job from the customer at the print processing system controller via the network communication link (please note Fig.2, items 26,34 and 66 where the received email or (data file) is received by the communication link to POD and AD compiler, page 2 paragraph 0030 through 0033) ((page 5 lines 11-34 and page 6 lines 1-7)) and associating at least one of the advertisements with the print job based on the data file for the print job (please note Fig.2&4 page 3 paragraph 0039 through 0040) ((please note page 8 lines 10-34 and page 9 lines 1-8)). However Zehr et al do not disclose: associating at least one of the advertisements with the print job based on the content of the print job and the profile of the advertisements. On the other hand Kawai et al disclose: associating at least one of the advertisement with the print job based on the content of the print job and the profile of the advertisements (note column 16 lines 13-25 and specifically 13-15 where the advertisement is automatically selected based on user's profile) Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Zehr et al's invention according to the teaching of Kawai et al, where Kawai et al in the same field of endeavor goes further to automatically select the proper advertisement for the purpose of matching it with the proper print job.

Regarding claim 12 Zehr et al disclose: The method of claim 1, wherein the step of defining the network communication link includes defining an Internet communication link between the customer and the print processing system controller (please note page 2 paragraph 0030) or ((page 5 lines 11-16)).

Regarding claim 15 Zehr et al disclose: The method of claim 6, wherein the step of associating the at least one of the advertisements includes querying the customer for approval of associating the at least one of the advertisements with the print job and receiving a response thereto, and wherein printing the at least one of the advertisements includes printing the at least one of the advertisements with the print job if the response is favorable (please note page 2 paragraph 0031) or ((page 5 lines 17-32)).

Regarding claim 16 Zehr et al disclose: The method of claim 1, further comprising the step of: registering the advertisements with the print processing system Controller (please note page 3 paragraph 0039) or ((page 8 lines 10-22)).

Regarding claim 17 Zehr et al disclose: The method of claim 8, wherein the step of defining the network communication link includes defining the network communication link between at least one advertiser, the customer, and the print processing system controller (please note Fig.2 items 26,66 and 44, page 2 paragraphs 0027 through 0032) or ((page 4 lines 27-34 and page 5 lines 1-31)) and wherein the step of registering the advertisements includes registering at least one advertisement of the at least one advertiser with the print processing system controller via the network communication link (please note page 3 paragraphs 0039) or ((page 8 lines 10-22)).

Regarding claim 18 Zehr et al disclose: The method of claim 8, wherein the step of registering the advertisements includes storing the advertisements and wherein the step of associating the at least one of the advertisements includes retrieving the at least

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one of the advertisements (please note page 4 paragraph 0040) or ((page 8 lines 23-34 and page 9 lines 1-8)).

4. Claims 13-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Zehr et al (Pub. No.: US 20010025274) in view of Kawai et al (U.S. Patent 6,404,994) and further in view of Pierce et al (U.S. patent 6,327,580).

Regarding claim 13 Neither Zehr et al nor Kawai et al disclose: The method of claim 11, wherein the step of associating the at least one of the advertisements includes associating the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements. On the other hand Pierce et al disclose: The method of claim 11, wherein the step of associating the at least one of the advertisements includes associating the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements (note Pierce et al, column 8 lines 35-39 and lines 59-60 where profile of the advertisement is known also note Pierce et al, column 8 lines 54-58 where the advertiser must reconciled with restriction data of the user) Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Zehr et al and Kawai's invention according to the teaching of Pierce et al, where Pierce et al in the same field of endeavor goes further to match the advertisement required by the user to be selected.

Regarding claim 14 Pierce et al disclose: The method of claim 3, wherein each of the advertisements have a profile associated therewith, and wherein the step of associating the at least one of the advertisements includes comparing the content of the

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print job with the profile of the advertisements (note Pierce et al, column 8 lines 54-58 where the advertiser must reconciled with restriction data of the user).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-21 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zehr et al (Pub. No.: US 20010025274) in view of Pierce et al (U.S. Patent 6,327,580)

Regarding claim 19, A system for processing a print job of a customer and including advertisements with the print job, the system comprising: A print processing system controller configured to have a plurality of advertisements registered therewith, each of the advertisements having a profile associated therewith (note Pierce et al, column 8 lines 35-39 and lines 59-60 where profile of the advertisement is known) wherein the print processing system controller is adapted to receive a data file for the print job from the customer, determine a content of the print job from the data file, and automatically select at least one of the advertisements for the print job based on the content of the print job and the profile of the advertisements (note Pierce et al, column 8 lines 54-58 where the advertiser must reconciled with restriction data of the user).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Zehr et al's invention according to the teaching of Pierce et al, where Pierce et al in the same field of endeavor goes further to automatically select the

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proper advertisement for the purpose of matching it with the proper print job with the content of the print data.

Regarding claim 20 Zehr et al disclose: The system of claim 19, wherein the print processing system controller is configured to communicate with the customer via a network communication link (please note Fig.2 items 26,34,66 and 44) and wherein the print processing system controller is adapted to receive the data file for the print job from the customer via the network communication link (please note page2 paragraph 0027 through 0030) or ((page 4 lines 27-34 and page 5 lines 1-16)).

Regarding claim 21 the system of claim 20 wherein the network communication link is an Internet communication link (note Zehr et al, page 7, paragraph 0070).

Regarding claim 24 Pierce et al disclose: The method of claim 11, wherein the step of associating the at least one of the advertisements includes associating the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements (note Pierce et al, column 8 lines 35-39 and lines 59-60 where profile of the advertisement is known also note Pierce et al, column 8 lines 54-58 where the advertiser must reconciled with restriction data of the user).

Regarding claim 25 Zehr et al disclose: The method of claim 6, wherein the step of associating the at least one of the advertisements includes querying the customer for approval of associating the at least one of the advertisements with the print job and receiving a response thereto, and wherein printing the at least one of the advertisements includes printing the at least one of the advertisements with the print job



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if the response is favorable (please note page 2 paragraph 0031) or ((page 5 lines 17-32)).

Regarding claim 26 Zehr et al disclose: The method of claim 8, wherein the step of defining the network communication link includes defining the network communication link between at least one advertiser, the customer, and the print processing system controller (please note Fig.2 items 26,66 and 44, page 2 paragraphs 0027 through 0032) or ((page 4 lines 27-34 and page 5 lines 1-31)) and wherein the step of registering the advertisements includes registering at least one advertisement of the at least one advertiser with the print processing system controller via the network communication link (please note page 3 paragraphs 0039) or ((page 8 lines 10-22)).

Regarding claim 27 the system of claim 20 wherein the network communication link is an Internet communication link (note Zehr et al, page 7, paragraph 0070).

Regarding claim 28 Zehr et al disclose: The system of claim 19, further comprising: a print processing data storage system configured to communicate with the print processing system controller and store the advertisements therein (please note page 4 paragraph 0040) or ((page 8 lines 22-34 and page 9 lines 1-8)).

### **Contact Information**

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

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The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark  
"EXPEDITED PROCEDURE")

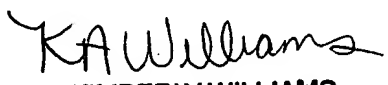
**Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label  
"PROPOSED" or "DRAFT")

**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy  
Patent Examiner  
Group Art Unit 2626  
October 11, 2005

  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER